

REMARKS

Claim 1 is cancelled. Claims 2-20 are pending in the application. Claims 13 and 14 are currently amended.

The Examiner rejected Claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,456,027 to Tecchio et al. The Examiner indicated that "Tecchio et al. '027 discloses all the limitations of the claims including... a lower sole element 140 releasably attached to the upper sole element such that a lateral relative motion between the upper sole element and the lower sole element is prevented and longitudinal motion between the upper and lower sole elements is resisted up to a predetermined release force." (See Abstract and col. 20, line 16-col. 21, line 48).

Applicant respectfully submits that, contrary to the Examiner's characterization, Tecchio describes an athletic shoe with a detachable sole having an electronic breakaway system including an electronic sensor assembly which "continually senses all of the sheer forces being applied and sends signals to the electronic control assembly 400. The electronic control 400 then sends these electronic signals to the adjustable release mechanism 500 if the sheer force of that incident has exceeded the preset delta time interval and stress force level F for the athlete, the trigger release mechanism 600 is activated..."(Column 20, line 62-Column 21, line 2). Accordingly, the shoe system disclosed in Tecchio includes strain gauges or sensors which sense sheer forces from unspecified directions.

Applicant respectfully submits that nothing in Tecchio teaches or suggests a release mechanism that actuates upon exertion of a sheer force in a constrained direction such as a longitudinal sheer force or a lateral sheer force. Rather, Tecchio teaches that "two conditions must occur before the trigger release mechanism 600 is activated... when both the preset delta time interval is exceeded and the preset sheer force F is exceeded, the simultaneous occurrence of both of these conditions will then cause electronic signals to be sent from the internal time adjuster 520 to the pressure release potentiometer 524 and then to the threshold level indicator... which will result in the detachment of the lower sole member 140 from the upper sole member 129 of athletic shoe 10." (Col. 21, lines 5-19). Neither of these conditions require a force in a particular direction.

Furthermore, Applicant submits that nothing in Tecchio teaches or suggests any elements that would prevent lateral relative motion between the upper sole element and lower sole element and resist longitudinal motion between the upper sole element and the lower sole element up to a predetermined release force as particularly claimed in claim 2. Since Tecchio does not teach or suggest “a lower sole element releasably attached to said upper sole element such that the lateral relative motion between said upper sole element and said lower sole element is prevented and longitudinal motion between said upper sole element and lower sole element is resisted up to a predetermined release force,” as particularly claimed in claim 2, Applicant respectfully submits that the Examiner’s rejection of claim 2 under 35 U.S.C. §102 is improper and it should be withdrawn.

The Examiner rejected claims 1-4, 12, 15-16, and 18-20 under 35 U.S.C. 102(b) as being anticipated by Ouellette et al. 5,644,857. The Examiner indicated that “Oullette et al. ‘857 discloses all the limitations of the claims including... the first sole element is associated with the second sole element such that when a threshold force is applied to one of the first sole element and the second sole element, the threshold forces causes the first sole element and the second sole element to translate longitudinally relative to each other (note portions 42 and associated portions 45 as well as 28 and associated portions 30, they will translate at a predetermined , i.e. known, force)...”

Applicant respectfully submits that contrary to the Examiner’s characterization, Ouellette discloses golf shoes with interchangeable soles that cannot translate longitudinally or laterally relative to upper shoe 12. It is clear from the description and, for example, from figure 2 of Ouellette that heel pin 24 is constrained in heel pin aperture 22 by push button release mechanism 20 so that no relative motion is allowed between interchangeable sole 14 and upper shoe 12. Further securing of interchangeable sole 14 and upper shoe 12 is provided by T-pins 36 (which are not “sheer pins” as erroneously characterized by the Examiner) which are inserted in parallel apertures 32. Although a small amount of relative motion between T-pins and apertures 32 is allowed by slots 34, these are clearly retention features and not features designed to resist longitudinal motion up to a predetermined release force or to release longitudinally after a predetermined release force. Applicant respectfully submits that the interchangeable soles disclosed in Ouellette have nothing to do with an athletic shoe having a releasable sole when

subject to a predetermined force. Since nothing in Ouellette teaches or suggests “a lower sole element releasably attached to said upper sole element such that lateral relative motion between said upper sole element and said lower sole element is prevented and longitudinal motion between said upper sole element and lower sole element is resisted up to a predetermined release force as particularly claimed in claims 1-4, 12, 15-16 and 18-20. Applicant respectfully submits that the rejection of these claims under 35 U.S.C. §103(a) should be withdrawn.

The Examiner rejected Claims 5-9 “under 35 U.S.C. 103(a) as being unpatentable over Oullette et al. 5,644,857 as applied to claim 3 above in view of Starks 1,831,268.” The Examiner admitted that “Oullette et al. ‘857 does not disclose the breakaway portion extending through the longitudinal guiding elements.” Again the Examiner mischaracterized T-pins 36 and heel pin 24 of Ouellette as “sheer pins”. Applicant respectfully submits that persons having ordinary skill in the art understand that sheer pins are designed to yield at a predetermined sheer force and are so calibrated. Nothing in Ouellette suggests that pins 36 or 24 are designed to yield at any particular force. On the contrary, persons having ordinary skill in the art would understand that pins 36 and 24 are not designed to yield. Further, the word sheer, or any synonym therefore, does not appear at all in Oullette.

The Examiner erroneously indicated that Oullette discloses “the breakaway portion comprising a shear pin 36, 24; the breakaway portion comprising a controlled friction portion (between 44 and 42); the controlled friction portion comprises a plurality of teeth 45 and the shear pin being formed integrally with the lower sole.” Applicant respectfully submits that the cited portions of Oullette are completely mischaracterized by the Examiner.

Item 36 of Oullette is described and shown as being T-pins 36 which are inserted into parallel apertures 32. (Col. 5, lines 9-10). The T-pins and related structure are a “male mating means” (Col. 5, line 23) not shear pins as erroneously characterized by the Examiner. Similarly, item 24 of Oullette is described and shown as being a “[h]eel pin 24 [which] may freely be inserted into heel pin aperture 22 where it will matingly engage with the selectively engageable mechanism 60. The heel pin 24 may be considered to be the first male mating means...” (Col. 4, lines 28-32) and is not a shear pin as erroneously characterized by the Examiner. Applicant respectfully submits that Oullette does not teach or suggest the use of any type of “breakaway

portion” as particularly claimed in claim 5, shear pin as particularly claimed in claim 6 or any analogous structure.

Items 44 and 42 of Oullette which the examiner erroneously characterized as a “controlled friction portion” is described and shown as being “parallel dovetail elements 44 [which] are designed to be received in a sliding fashion in the parallel channels 42. The parallel dovetail elements 44 are chosen to be of the same length as the parallel channels 42 so they may slidably interfit within a minimal tolerance.” (Col. 5, lines 39-42). Applicant respectfully submits the dovetail elements 44 and parallel channels 42 of Oullette do not teach or suggest anything about a “breakaway portion” as particularly claimed in claim 5, a “controlled friction portion” as particularly claimed in claim 7, or any analogous structure.

Items 45 of Oullette which the Examiner erroneously characterized as a plurality of teeth are shown and described in Oullette as grooves wherein “the dovetail elements 44 have a plurality of orthogonally oriented grooves 45 located thereon. The grooves 45 facilitate flexibility of the sole 14. It is important that the sole 14 be resiliently flexible as it may be preferably flexed during the attachment and removal from the midsole 16. The parallel dovetail elements 44 and related structure may be considered to be the fourth male mating means.” (Col. 5, lines 47-48). Accordingly, contrary to the Examiner’s characterization, grooves 45 do not teach or suggest anything about a controlled friction portion or more particularly “a controlled friction portion comprising plurality of teeth and grooves” as claimed in claim 7.

Furthermore, it can be clearly seen that all embodiments of a removable sole described and claimed Oullette include a push button release mechanism between the sole and shoe upper which would defeat the functionality of any type of “breakaway portion” “controlled friction portion” “shear pin” “teeth and grooves” as claimed in claims 5-9 or controlled friction release structure.

The Examiner admitted that Oullette does not disclose “the breakaway portion extending through the longitudinal guiding elements” (page 4, lines 6-7) and erroneously indicated that U.S. Patent No. 1,831, 268 to Starks teaches pins 12 which could be placed in the guiding rails and slots of Oullette “to aid in holding the two soles together until the breaking force has been met.” Applicant respectfully submits that items 12 of Starks are described as “fastening elements such as nails or the like” for use in a detachable heel. Contrary to the Examiner’s

characterization, nothing in Starks teaches or suggests anything about a breakaway portion or any structure at all that is designed to hold together until a breaking force is met. Furthermore, nothing in Starks overcomes the deficiencies of Oullette set forth above.

Since Oullette and Starks alone or combined do not teach or suggest anything about a controlled friction portion as particularly claimed in claim 5, Applicant respectfully submits that the rejections of claims 5-9 under 35 U.S.C. 103(a) are improper and should be withdrawn.

The Examiner rejected claims 10 and 11 under 35 U.S.C. 103(a) over the references applied to claim 5 and indicated that because spot welds and adhesive “are well known art accepted equivalent means for pins used for fastening soles together... it would have been obvious ... to use any known means of fastening sole [sic] together, including spot welds, pins, screws, adhesives, to aid in holding the soles of the shoe together during use while still allowing for breakaway feature to operate at a given minimum applied force.” (page 4, lines 19-24). Contrary to the Examiner’s characterization, Applicant respectfully submits that persons having ordinary skill in the art understand that spot welds, pins, screws and adhesives, generally are not designed to break away at all and would not allow for a breakaway feature to operate at a given minimum applied force. For this reason and for the reasons set forth herein with respect to claim 5, applicant respectfully submits that no combination of Oullette and Starks teaches or suggests each element of claims 10 and 11. Accordingly, Applicant submits that the rejections of claims 10 and 11 under 35 U.S.C. 103(a) are improper and should be withdrawn.

Claims 13 and 14 are amended herein to depend from claim 12. Applicant submits that the dependency of claims 13 and 14 from claim 5 as originally filed was a clerical error which applicant submits should not have effected and apparently did not effect the examination and Examiner’s rejections of claims 13 and 14. The Examiner rejected claims 13 and 14 under 35 U.S.C. 103(a) over Oullette and Starks in view of Tecchio. Applicant respectfully submits that the Examiner erroneously indicated that “Tecchio teaches that a ligament portion, that portion which attaches one sole to the other, can be attached by a spring loaded mechanism which disengages one sole from the other.” (Page 5, lines 1–2). Applicant respectfully submits that the spring biased latch mechanism that is used to disengage one sole from the other as disclosed in Tecchio is a complex electrically actuated piston system that has nothing to do with a “ligament portion” as particularly claimed in claims 13 and 14. The Examiner’s characterization begins

with the erroneous premise that a ligament portion is defined as “that portion which attaches one sole to the other”.

Contrary to the Examiner’s characterization, the claimed ligament portion is not anticipated by every portion which attaches one sole to another but is rather a specific type of structure as shown in Fig. 10, and as claimed in claims 12 – 14 such as a band or a spring, for example, that is capable of “preventing longitudinal translation between said upper sole and said lower sole unless a force exceeding a predetermined shear force is exerted therebetween. The complex electronically actuated spring mechanism of Tecchio does not teach or suggest such specific structure or structure analogous to that which is particularly claimed in claims 13 and 14. Applicant further submits that Tecchio does not cure the deficiencies of Oullette and Starks as described herein with respect to claim 5.

Since no combination of Oullette, Starks and/or Tecchio teaches or suggests “a ligament portion connected between said upper sole and said lower sole and preventing longitudinal translation between said upper sole and said lower sole unless a force exceeding a predetermined shear force is exerted therebetween” as particularly claimed in claims 13 and 14 as amended, Applicant respectfully requests that the rejections of claims 13 and 14 under 35 U.S.C. 103(a) be withdrawn.

The Examiner rejected claim 17 under 35 U.S.C. 103(a) over Oullette. The Examiner erroneously indicated that “the shear pin 24 is aligned with and part of the cleat 18 and therefore teaches that the pin can be associated with the cleat with the pin extending through the upper and lower sole portions.” For the reasons set forth herein with respect to claim 16, and especially because, contrary to the Examiner’s mischaracterization, Oullette does not teach or suggest a shear pin, Applicant respectfully submits that Oullette does not teach or suggest an athletic shoe ‘wherein at least one cleat includes a shear pin...’ as particularly claimed in claim 17. Accordingly, Applicant submits the Examiner’s rejection of claim 17 under 35 U.S.C. 103(a) is improper and should be withdrawn.

CONCLUSION

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. The Examiner is invited and encouraged to telephone the undersigned with any concerns in furtherance of the prosecution of the present application.

Please charge any deficiency as well as any other fee(s) which may become due at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-0369. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 50-0369 therefor.

Respectfully submitted,

June 28, 2006
Dated: _____

Joseph P. Quinn
Joseph P. Quinn
Reg. No. 45,029
Customer No. 21710
Attorney for Applicant(s)
BROWN RUDNICK BERLACK ISRAELS LLP
One Financial Center
Box IP
Boston, MA 02111
Tel: 617-856-8396
Fax: 617 856-8201